

REMARKS/ARGUMENTS

The Examiner has objected to Applicant's amendment filed on November 22, 2004 for being not fully responsive to the prior Office Action of August 18, 2004. Specifically, the Examiner has stated that paragraphs 1 and 5 were not addressed/complied with.

Paragraph 1 of the August 18, 2004 Office Action:

In paragraph 1, the Examiner asserted that the Applicant's claim of benefit of an earlier filed date under 35 U.S.C. § 120 is faulty. Specifically, the Examiner used form paragraph 2.10 from M.P.E.P. § 201.11 reciting that the "disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. § 112."

Applicant cannot agree. Specifically, Applicant believes there is no rejection to reply to, as the Examiner has merely recited a requirement for receiving the benefit of an earlier filed date under 35 U.S.C. § 120, but has failed to provide any grounds for rejection. As there are no grounds for rejection, it is impossible for Applicant to formulate a response.

Further, the Examiner has failed to establish a prima facie case of failure to receive the benefit of an earlier filing date under 35 U.S.C. § 120 for failure to comply with requirements of first paragraph of 35 U.S.C. § 112. Specifically, first paragraph, 35 U.S.C. § 112 has both a written description requirement and an enablement requirement. See M.P.E.P. 2163 and 2164. For rejections based either on lack of written description or lack of enablement, the Examiner bears a specific burden of establishing a prima facie case. See M.P.E.P. 2163.04 and 2164.04. For lack of written description, a description as filed is presumed to be adequate, until sufficient evidence to the contrary has been presented by the Examiner to rebut the

presumption. Therefore, the Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.

Accordingly, M.P.E.P. 2163.04 sets forth the Examiner's burden to include a) identifying the claim limitation at issue; and b) providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure as filed.

Likewise, for rejection by the Examiner based on a lack of enablement requirement, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See M.P.E.P. 2164.04. Specifically, when rejecting a claim under the enablement requirement of section 112, the examiner bears the "initial burden of setting forth a reasonable explanation as to why [he/she] believes that the scope of protection provided by [the] claim is not adequately enabled by the description of the invention provided in the specification." In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). To object to a specification on the grounds that the disclosure is not enabling with respect to the scope of a claim sought to be patented, the examiner must provide evidence or technical reasoning substantiating those doubts. Id.; and M.P.E.P. § 2164.04. Without a reason to doubt the truth of the statements made in the patent application, the application must be considered enabling. In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993); In re Marzocchi, 439 F.2d 220, 223, 169 U.S.P.Q. 367, 369 (CCPA 1971). The burden placed on the examiner is reflected in the M.P.E.P. § 706.03. Accordingly, the case law makes clear that properly reasoned and supported

statements explaining any failure to comply with § 112 are a requirement to support a rejection. In re Wright, F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993).

Accordingly, it can be seen that the Examiner has neither established a prima facie case for lack of written description or a prima facie case for lack of enablement. Applicant submits without additional reasoning, the Examiner's objection of paragraph 1, must be withdrawn.

Regarding paragraph 2 of the Office Action:

The Examiner has objected to the drawings stating that reference numeral 74 in Fig. 3 should be numeral 72 and reference numeral 102A is missing.

In response, the Applicant has eliminated the second occurrence of numeral 74 from Fig. 3 and has amended the specification to change numeral 102A to 82A to overcome these objections.

The drawings additionally have been objected to under 37 C.F.R. 1.83(a) because the drawings must show each and every feature of the invention specified in the claims. In response, claims 1-11 have been canceled and replaced with new claims 12-14 to overcome this objection. The newly submitted claims 12-14 are properly supported by the existing figures.

Regarding paragraph 3 of the Office Action:

The Examiner has objected to the specification for informalities regarding numerals 60, 86, and 32. In response, Applicant has amended the specification to adopt the Examiner's suggested amendments.

Regarding paragraph 4 of the Office Action:

The Examiner has rejected claims 1-11 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or which it most nearly

connected, to make or use the invention. Specifically, the Examiner believes claim 1 recites a combination of features of Figs. 6-10 reciting "threads . . . normally extending through the bathtub overflow port", and features of Figs. 1-5, such as "the overflow port having a flange".

In response, Applicant has canceled claims 1-11 and replaced them with new claims 12-14. Applicant believes claims 12-14 properly depend on the specification. New claims 12-14 are considered in allowable form. Specifically, Applicant believes new claim 12 is completely supported by the features of the Figs. 1-5 embodiment, and claims 13-14 are supported by features of the Figs. 1-5 embodiment as well as being separately supported by the features of the Figs. 6-10 embodiment. Accordingly, Applicant believes the rejection is overcome.

Regarding paragraph 5 of the Office Action:

The Advisory Action has listed paragraph 5 as not being addressed or complied with. Applicant cannot agree. Specifically, no rejections are provided in paragraph 5, instead the Examiner has merely referred the Applicant to the M.P.E.P. § 714.02 and 608.01(o) reciting that the amendment must be fully responsive and that there must be basis for claim terminology in the description, respectively.

Regarding M.P.E.P. 714.02, Applicant fails to see how a rejection for the Applicant not fully being responsive can be based on the M.P.E.P. section stating that the application must be fully responsive. For an application to be not fully responsive under 714.02, the Applicant must have not responded to a specific rejection, and 714.02 is not an independent grounds for rejection.

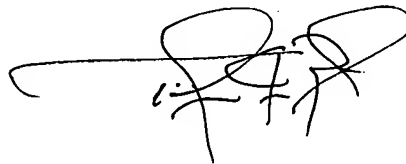
Likewise, M.P.E.P. 608.01(o) has not been cited for any specific rejection. Accordingly, Applicant submits that this is an insufficient basis for a notice of defective response.

Specifically, Applicant believes that since no grounds were stated by the Examiner under 608.01(o) in the August 18, 2004 Office Action, that any rejection by the Examiner under 608.01(o) must be established in the next office action and not subject to a notice of defective response. Further, Applicant can find no affirmative duty on the part of the Applicant to identify the basis for claim terminology in the amendment itself. Rather, 608.01(o) instead establishes a burden for the Examiner to ensure that the terms and phrases used in the claims find clear support or antecedent basis in the description.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200. All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



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Attachments

Amendment to the Drawings:

The attached sheet of drawings includes changes to Fig. 3. This sheet, which includes Fig. 3, replaces the original sheet including Fig. 3. In Fig. 3, the second occurrence of numeral 74 has been eliminated. Please see the Annotated marked up drawing showing the change in red ink also attached and considered a part of the remarks section to identify the change.

Attachment: Replacement Sheet
 Annotated Sheet Showing Changes



Appl. No. 10/674,862
Reply to office action of Aug. 18, 2004
Annotated Sheet Showing Changes

